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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,288	08/01/2003	Charles L. Branch	MSDI-261/PC750.00	3338
52196 7590 10/16/2007 KRIEG DEVAULT LLP ONE INDIANA SQUARE, SUITE 2800 INDIANAPOLIS, IN 46204-2709			EXAMINER RAMANA, ANURADHA	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 10/16/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/633,288

Applicant(s)

BRANCH ET AL.

Examiner

Anu Ramana

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29,31-40,42-49 and 55-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29,31-40,42-49 and 55-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 16-21, 26-29, 31, 36-40, 46-49 and 55-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Parker et al. (US 6,185,356).

Parker et al. disclose a surgical instrument including a retractor 2860 and a lighting element including multiple transmitting elements enclosed in a protective cover 2500 having cover portions or "wall members" 2500A and 2500B wherein the cover portions can be made from an opaque or translucent material and are attached along opposite lateral edges to form unitary protective cover 2500 (Figs. 25A, 25B, 28A and 28B, col. 7, lines 6-45, col. 16, lines 13-65, col. 17, lines 19-35 and col. 18, lines 50-62).

Claims 1-2, 4-8, 16-21, 26-27, 29, 31, 36-37, 39-40 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Davis (US 3,796,214).

Davis discloses a surgical instrument including a retractor 12 and a fiber optic bundle or lighting element including a plurality of light transmitting elements or fibers frictionally engageable within the wall surface 50 and/or 51 of retractor 12 (Figs. 1-4, col. 2, lines 10-68, col. 3 and col. 4, lines 1-10).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al. (US 6,185,356) in view of McDonald (US 3,807,393).

Parker et al. disclose that their light distributor can be in the form of a flexible optic light guide (col. 15, lines 4-27).

Parker et al. disclose all elements of Applicants' claimed invention except for the light distributor being a fiber optic bundle.

McDonald teaches the use of a fiber optic bundle as a light distributor so that a surgical site can be illuminated without any danger of burning a patient (col. 7, lines 35-54).

It would have been obvious to one of ordinary skill in the art to substitute a fiber optic bundle as, for example, taught by the McDonald reference for the light distributor of the Parker et al. device wherein so doing would amount to mere substitution of one functionally equivalent light distributor for another within the same art and the selection of any of these light distributors would work equally well in the claimed device.

Claims 9-14, 22-24, 32-34 and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al. (US 6,185,356).

Although Parker et al. do not disclose that the cover portions are convexly and concavely shaped, it would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the cover portions with convex and concave shapes, since applicant has not disclosed that this solves any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of providing a cover portion. *In re Dailey and Eilers*, 149 USPQ 47 (1966).

Claims 15, 25, 35 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al. (US 6,185,356) in view of Zhu et al. (US 5,293,863).

Parker et al. disclose that their lighting element can be attached to any accessory device (col. 18, lines 50-51).

Zhu et al. teach a tubular retractor for use during endoscopic surgery (Fig. 2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the lighting device of Parker et al. with the Zhu et al. device to provide lighting during endoscopic surgery.

The combination of Parker et al. and Zhu et al. discloses all elements of the claimed invention except for the tube being made of a translucent plastic material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have constructed the device of the combination of Parker et al. and Zhu et al. of a translucent plastic material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

### ***Response to Arguments***

Applicants' arguments submitted under "REMARKS" in the response filed on August 1, 2007 have been fully considered.

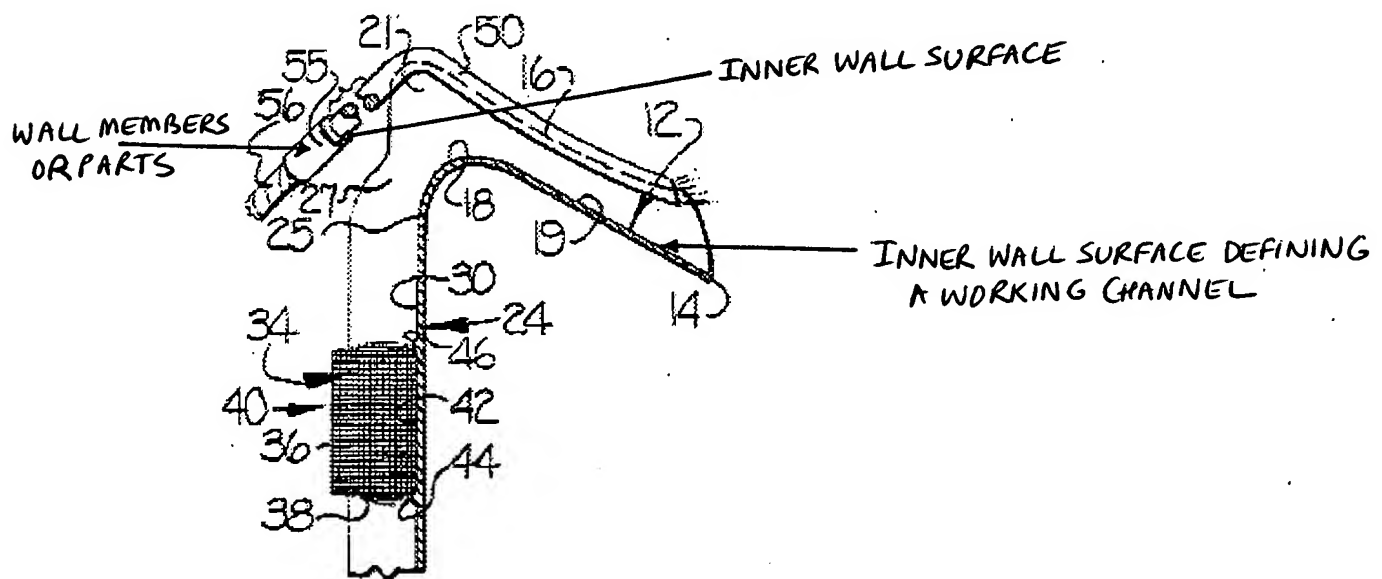
Applicants' arguments with respect to the rejections under 35 USC 102(b) over Parker et al. are not persuasive for the following reason.

The limitation "frictionally engageable with said inner wall surface, said frictional engagement sufficient to maintain a position of said lighting element relative to said retractor" only requires the lighting element to have the capability of being frictionally engageable with the inner wall surface of the retractor. As illustrated in Fig. 28A, the wall member 2807 is shown to be frictionally engageable with an inner wall surface of retractor 2860 via attachment member 2850. Contrary to Applicant's arguments, Parker et al. clearly disclose in Fig. 28A and col. 18, lines 50-62, how the lighting element is attached to the retractor 2860. Regarding claims 26 and 36, the lighting element of Parker et al. is axially and circumferentially movable along the inner wall surface by means of attachment member 2850.

Applicants' arguments with respect to the rejections under 35 USC 102(b) over Davis are not persuasive for the following reason.

As previously stated, the limitation "frictionally engageable with said inner wall surface, said frictional engagement sufficient to maintain a position of said lighting element relative to said retractor" only requires the lighting element to have the capability of being frictionally engageable with the inner wall surface of the retractor. The light transmitting elements or fibers of Davis are frictionally engageable with the inside wall surface of members 50 and/or 51 (col. 3, lines 25-58). Regarding claims 26 and 36, the light transmitting elements of Davis are axially and circumferentially movable along the inner wall surfaces of members 50 and 51.

Regarding claim 46, Davis discloses a coupler 55 including a pair of wall members or parts that are oriented toward the working channel of the retractor. See marked up Fig. 4 from Davis below.



Regarding the rejections under 35 USC 103(a) over Parker et al., it is noted that Parker et al. clearly discloses that the lighting device can have a cross-sectional area of any shape. It is also noted that a person of ordinary skill in the art has good reason to choose from a finite number of available shapes, i.e., known options within his or her technical grasp, for providing a cover to a lighting element.

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**Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR  
October 13, 2007

*Anuradha Ramana*  
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